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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,919	02/27/2004	Geoffery H. Dreyer	435565-405	7488

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09/13/2005

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EXAMINER

ALPERT, JAMES M

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,919

Applicant(s)

DREYER ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101 - #1

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

With regard to Claims 1, the claimed invention is directed to non-statutory subject matter. Whether a claimed invention relating to business methods is directed to statutory subject matter is governed by State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Pursuant to the holding in this case, computer claims should be treated like any other process claims (MPEP § 2106). Claim 1 relates to a "closing package" comprising various items. The claims is on its face non-statutory, as a "closing package" is not a process nor is it a machine, manufacture of composition of matter.

Claim Rejections - 35 USC § 101 - #2

Claims 2-5 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claims. Without a technological basis, the claims may be interpreted, in an alternative, as involving no more than a manipulation of an abstract idea, and are therefore non-statutory under 35 U.S.C. 101. In contrast, for example, a method claim that includes in the body of the claim a structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not

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precedential]. Claims 2-5 each relate to a method for refinancing a mortgage loan package. However, the preamble and the body of the claims do not indicate that the claims are within the technological arts. To overcome this deficiency, claim language should be considered such that both the preamble and body of the claim indicate that they are grounded within a technological art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al, U.S. Patent Application Publication #20020029194. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody et al, U.S. Patent Application Publication #20020077964, in view of Lewis.

With regard to Claim 1, Lewis teaches the a closing package comprising: at least one document comprising a plurality of acknowledgements, agreements, and disclosures accommodating variations in legal requirements relating to said closing documents. (Page 18, Claim 23, Para. 1-4).

Lewis does not specifically discuss the use of: instructions providing guidance to said customer for completing and executing said closing documents comprising a checklist of steps for said customer's guidance and steps for a notary's guidance in said completion and execution of said closing documents;

However, this limitation is obvious in view of what is old and well known in the art. That is to say, in many complex financial transactions, particularly those involving electronic commerce technologies, it is common to have accompanying read-me files or other media that lay out instructions for completing important tasks. Thus the examiner takes official notice of this limitation, and observes that it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Lewis, relating to a package of closing documents and corresponding agreements and rules, to include an instruction set for completing the documents. The motivation for such a combination is to encourage use of the system or method by making it as simple as possible on the person seeking financing.

With regard to Claims 2-3, Brody teaches a method comprising:

pre-approving a customer for refinancing of a mortgage loan;
(Paras. 11-13 and Para. 68, describing pre-approved mortgages)

sending an offer for said refinancing to said customer
(Para. 15)

Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art. For example, language directed to an intended use of dispensing popcorn in a claim for a product did not result in a structural or functional difference with respect to prior art and were held not to serve as a limitation on the claim. See In re Schreiber, 44 USPQ2d 1429 (CAFC 1997).

Thus, a limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See In re Gulack, 217 USPQ 401 (CAFC 1983), Ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and In re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Brody does not expressly teach that the offer expressly comprises:
materials setting forth terms of said refinanced mortgage loan, at least one of said terms of said refinanced mortgage loan comprising a specific, locked interest rate;
materials providing pre-acceptance disclosures and conditions, and
instructions describing how said customer may accept said offer;

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. That is to say, the exact type of material included in the offer does not effect the step of providing an offer. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the above described materials, because the type of material does not functionally relate to the steps in the method claimed and does not patentably distinguish the claimed invention. Continuing the analysis, Brody teaches the method further comprising:

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receiving an indication of acceptance of said offer from said customer; and
(Para. 16)

Brody does not specifically teach the step comprising:

sending a closing package to said customer to be executed by said customer, said closing package.

However, in an analogous application, Lewis teaches this limitation at (Page 18, Claim 23, Para. 4), which describes presenting documents to the offeree. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Brody, relating to pre-approving, offering and accepting mortgage agreements, with the teachings of Lewis, relating to providing a closing package. The motivation for such a combination would be to help ease problems related to multiple inquiries on a credit report, in that the process is a one step process, rather than several steps. Further, there would be benefits to streamlining the process down to a simpler form.

Brody nor Lewis expressly disclose that the closing package comprises:

at least one document comprising

instructions providing guidance to said customer for completing and executing said closing documents in the absence of a meeting, said instructions comprising

a checklist of steps for said customer's guidance and steps for a notary's guidance in said completion and execution of said closing documents, and

at least one document comprising a plurality of acknowledgements, agreements, and disclosures accommodating variations in legal requirements relating to said closing documents,

said execution of said closing documents by said customer creating a refinancing loan agreement.

However, as with the above limitations, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited.

That is to say, the exact type of material included in the closing package does not effect the step of providing a closing package. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the above described closing documents, because the type of material does not functionally relate to the steps in the method claimed and does not patentably distinguish the claimed invention.

With regard to Claim 4, the only distinction between this claim is found in the descriptive material, and comprises a specification that as part of the materials included in the offer, that there be one term comprising an interest rate and a term length. Therefore, this claim is rejected under a similar analysis as Claims 2-3.

With regard to Claim 5, the only distinction between this claim and Claim 2 is that a request for financing initiates the refinancing process rather than a pre-approval step. However, this distinction is old and well known in the art, in that a request for a loan or mortgages, electronically or otherwise, is very, very common. Further, Brody actually teaches this claim in that potential approvees are allowed to opt in or out of the pre-approval process, allowing the consumer to initiate the process. See (Figure #5 and Page 10-11, Para. 83). Brody anticipates the distinction in the claim, and the claim is rejected under a similar analysis as Claim 2.

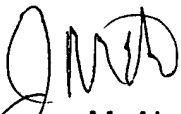
Conclusion

THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached

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on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.


James M. Alpert
29 August 2005



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